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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09898164
Filing Date: 2 July 2001
Appellant(s): HASELTINE ET AL.

Farshad Farjami, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 April 2008 appealing from the Office action mailed 5 November 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Lappington et al., US005638113A, 10 June 1997

Brusky et al., US005903259A, 11 May 1999

Mankovitz et al., US005523794A, 4 June 1996.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 5 November 2007. Claims 69-72 have been cancelled, but the text of that rejection has been retained here because it supports a subsequent rejection.

DETAILED ACTION

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 69-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Lappington et al. (US005638113A).

7. Lappington et al. teaches (independent claim 69) a method for providing an incentive to a user to receive information by providing a plurality of tokens embedded in a programming broadcast signal, the method comprising:

receiving, by a user device (*handheld **32***, col. 9 lines 1-8), a first token of the plurality of tokens (*a plurality of transactions*, col. 5 lines 5-16) transmitted from a broadcast receiving appliance (*settop device **28***) receiving the programming broadcast signal, wherein the first token is indicative of a guessing round (col. 2 lines 50-53);

registering, by the user device, an answer from the user to the guessing round (col. 11 lines 44-45);

receiving, by the user device, a second token (a message would be displayed, col. 11 lines 45-48) of the plurality of tokens transmitted from the broadcast receiving appliance receiving the programming broadcast signal, wherein the second token is indicative of a correct answer;

comparing, by the user device, the answer from the user with the correct answer (col. 11 lines 45-48);

registering, by the user device, a point for the user if the answer from the user matches with the correct answer (col. 11 lines 45-48).

8. Lappington et al. also teaches claims 70 (inherently), 71 (col. 11 lines 44-48) and 72 (col. 9 lines 10-12)

9. Claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lappington et al. (US005638113A) in view of in view of Brusky et al. (US005903259A).

10. Lappington et al. also teaches (independent claims 1, 38, 58 and 65, at col. 8 lines 53-57):

providing the token embedded in an audio signal of the programming broadcast signal;

receiving, by the broadcast receiving appliance, the token embedded in the audio signal of the programming broadcast signal; and

emitting, by the broadcast receiving appliance, the audio signal including the token from the broadcast receiving appliance.

11. Lappington et al. does not teach that the token is emitted outside of a normal hearing frequency range of an acoustic spectrum of the audio signal. Brusky et al. teaches radiating an audio signal outside of a normal hearing frequency range of an acoustic spectrum (i.e., radiating *inaudible sounds*, col. 7 line 65 to col. 8 line 4). Because Brusky et al. teaches that infrared radiation, audible radiation and inaudible sound radiation provide *equivalent results*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Brusky et al. to those of Lappington et al.

12. Lappington et al. also teaches at the citations given above claims 2, 4, 8, 42, 44, 61 and 68.

13. Lappington et al. also teaches claims 11 and 41 (col. 4 lines 47-64); claim 43 (col. 4 line 26); and claim 45, where the interactive instructions downloaded to *handheld **32*** read on "a computer software program" (col. 9 lines 5-10 and 62-63).

14. Claims 10, 12, 13, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lappington et al. (US005638113A) in view of Brusky et al. (US005903259A) and further in view of Mankovitz et al. (US005523794A). Neither Lappington et al. nor Brusky et al. teach redemption of a token capture device(TCD). Mankovitz et al. teaches redemption of a token capture device (*portable data coupon*, col. 8 lines 24-51). Because Mankovitz et al. teaches that the TCD/*portable data coupon* is capable of redeeming e-coupons using the existing retail infrastructure (col. 8 lines 35-41), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Mankovitz et al. to those of Lappington et al. and Brusky et al. For claim 40, a *discount* or any other benefit reads on a "prize". For claims 12 and 13, Lappington et al. teaches collecting personal information for demographic analysis (col. 10 lines 50-64).

(10) Response to Argument

A. Argument for claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65 and 68 rejected under 35 U.S.C. 103(a) as being unpatentable over Lappington et al. (US005638113A) in view of in view of Brusky et al. (US005903259A).

Appellant argues (pp. 7-8 of 20) that Lappington et al. fails to teach,

> "emitting, by the broadcast receiving appliance, the audio signal including the token from the broadcast receiving appliance" (first part of claim 1, 4th limitation).

The appellant ignores the rejection and argues an irrelevant embodiment. The appellant (top of brief p. 8 of 10) cites col. 9 lines 5-7 in Lappington et al., which is not a relevant embodiment. The relevant embodiment was cited at first line of rejection para. 10:

> "In an alternative embodiment, rather than using the VBI lines, interactive data could be transmitted using the audio portion of a television signal, luminance, digital

packets, radio communication or other appropriate mediums." (Lappington et al., col. 8 lines 53-57, emphasis added.)

The audio portion of a televise signal reads on "emitting, by the broadcast receiving appliance, the audio signal … from the broadcast receiving appliance". The reference further teaches that the signal includes "a plurality of transactions", where said "transactions" reads on "tokens" (para. 7 of the final rejection reproduced above).

Appellant also argues (p. 8 of 20), with reference to the advisory action mailed on 16 January 2008, "However, Appellant respectfully submits that 'radio communication does not mean 'audio emissions.'"[1] The appellant is challenging a literal statement by the examiner in the advisory action. Of course the examiner did not mean that radio communication literally was audio emission. Furthermore, the claim is not limited to "radio communication"; the claim is limited to emission by the broadcast receiving appliance:

"emitting, by the broadcast receiving appliance, the audio signal including the token from the broadcast receiving appliance" (emphasis added).

One of ordinary skill in the art would readily understand that the receiving appliance used in radio communication is a radio and that a radio inherently emits an audio signal. Furthermore, as noted above, the reference citation given in the final rejection teaches transmitting data using the audio portion of a television signal, which expressly reads on "emitting, by the broadcast receiving appliance, the audio signal including the token from the broadcast receiving appliance."

On p. 9 of 20, three paragraphs are quoted from Lappington et al. Appellant argues that the third of these paragraphs fails to teach the claim limitation. The examiner never said that that last paragraph taught the claim limitation. The pertinent teaching, as cited in the first line of rejection para. 10, is given by the appellant at the end of the first paragraph quoted on p. 9 of 20. The appellant ignores this rejection citation in favor of emphasizing irrelevant material in the emphasized last paragraph quoted on p. 9 of 20.

[1] It is noted that the appellant has on p. 8 of 20 introduced new evidence, a citation from Wikipedia, which has not been made of record nor has a copy been provided to the Office. Since this reference is irrelevant to the claimed invention, the examiner suggests, for the sake of expediency, that the Board not return the case to the appellant to correct this formal error.

Appellant argues (p. 11 of 20) that Brusky fails to teach this limitation,

"wherein the token is emitted outside of a normal hearing frequency range of an acoustic spectrum of the audio signal".

The complete section cited by the final rejection (para. 11) is as follows:

"Furthermore, although the exemplary embodiments described above indicate infrared transmission for the remote control and/or wireless keyboard, it is understood that radio frequency, electromagnetic signals, sound waves (including audible and inaudible sounds) or other wireless communication transmitters and receivers can be used in the present exemplary embodiments with equivalent results. That is, the wireless keyboard can be used to control a plurality of electronic devices without having to use the remote control designated for the remotely controllable device." (Brusky et al., col. 7 lines 65 to col. 8 line 8, emphasis added.)

The appellant reasons,

"Appellant respectfully submits emissions outside of a normal hearing frequency range of an acoustic spectrum of the audio signal are not considered a "sound" to a human ear, and that "inaudible" refers to the volume of the transmitted "sound," which is within the normal hearing frequency range of an acoustic spectrum of the audio signal." (Middle of brief p. 11 of 20)

The appellant's interpretation would not make practical sense to one of ordinary skill in the communication art. The appellant argues that Brusky et al. advocates operating within the range of hearing but at such a low amplitude (volume) so as to be inaudible. If a person can't hear the sound, how is the receiving device supposed to "hear" the sound? Those of ordinary skill in the communication art would know full well that frequency shifting is a lot more reliable than amplitude modulation. Those of ordinary skill in the art would read "inaudible sound" as an acoustic wave outside of the range of hearing because that is the only interpretation consistent with communication practice.

The quotation from Brusky et al. is saying that any wireless means of communication produces "equivalent results". The paragraph cites a number of means, including "sound waves". It is true that Brusky et al. would have been more precise to write

"acoustic waves" in place of "sound waves", but one of ordinary skill in the art would have known full well what Brusky et al. meant.

For that matter, the claim limitation also uses language that is imprecise. The appellant refers (above) to "a human ear", but "sound" is widely understood to be perceived by any "hearing" creature, so the claims would subsume the dog hearing range, for example. The limitation to "a normal hearing frequency range of an acoustic spectrum of the audio signal" is not a precise statement of anything. "A normal hearing frequency range" has a clear meaning, but "of an acoustic spectrum of the audio signal" is meaningless. "A normal hearing frequency range" is an acoustic spectrum and really has nothing to do with "the audio signal". The examiner did not reject this language as indefinite because one of ordinary skill in the art could read through these imperfections of ordinary language so as to understand what is being claimed. One of ordinary skill in the art would similarly read through the imperfections of the ordinary language in Brusky et al. so as to understand what is being taught. One of ordinary skill in the art would conclude that Brusky et al. teaches the claim limitation.

B. Argument for claims 10, 12, 13, 39 and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over Lappington et al. (US005638113A) in view of in view of Brusky et al. (US005903259A) and further in view of Mankovitz et al. (US005523794A).

The appellant (p. 12 of 20) makes no new arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Donald L. Champagne/
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